

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE TTAB
JUNE 18, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Novations Group, Inc.

Serial No. 75/265,221

L. Craig Metcalf of Madson & Metcalf for applicant.

Jodi Lauterbach, Trademark Examining Attorney, Law Office
107 (Thomas Lamone, Managing Attorney).

Before Seeherman, Walters and Wendel, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Novations Group, Inc. has filed a trademark
application to register the mark FOUR STAGES for
"educational services; namely, conducting classes,
workshops, and seminars in the area of business management
and career development."¹

¹ Serial No. 75/265,221, in International Class 41, filed March 27,
1997, based on use of the mark in commerce, alleging first use as of
1975 and first use in commerce as of January 1986.

The Trademark Examining Attorney has finally refused registration on the following grounds:

- (1) Applicant's mark is merely descriptive of its services, under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1).
- (2) The specimens do not show use of the mark as it appears in the drawing, i.e., the mark in the drawing is an incomplete representation, a mutilation, of the mark as used on the specimens. The mark as it appears on the specimen is reproduced below.

- (3) The specimens, consisting of identical copies of a document entitled "M&PD Competency Assessment," are unacceptable because they do not show use of the mark in the sale or advertising of the services identified in the application.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested.

Descriptiveness

The Examining Attorney contends that the applied-for mark is merely descriptive in connection with the identified services because the term "four stages" merely describes the nature of its program and is used in this manner throughout the specimens of record, e.g., "[r]ead the four stage descriptions for each competency ... [e]ach of the stages describes high performance." The Examining Attorney notes that the theoretical model for applicant's services involves four stages of competency and that applicant uses the phrase "four stages" descriptively, and in all lower case letters, in the text of the specimen.

In support of her position, the Examining Attorney has made of record excerpts of articles from the LEXIS/NEXIS database that she contends refer to applicant and others as having adopted a four stage theoretical model in the areas of business management and career development. In particular, she submitted an article from the November 1986 issue of *Research & Development* by Paul Thompson, who applicant acknowledges is one of its founders. In this article about career development, Mr. Thompson states, "[a]fter more than 10 years of research into the careers of professional in organizations, we have found convincing evidence that the careers of professionals develop in

stages" and "[t]he four-stage framework has proved to be a useful tool in career development seminars, in one-on-one performance appraisals, and in long-range strategic planning sessions." An article in *Electronic Design*, November 17, 1997, attributes to the co-founders of applicant the creation of "the four-stage career model." Other articles excerpted refer generally to "the four stages of career development" or to other researchers' models of career development involving four stages.

Applicant contends that FOUR STAGES is, at most, suggestive of its identified services; that FOUR STAGES does not convey anything about the content of applicant's classes, rather, it relates "to the four possible levels of individual competencies assessed by applicant's program" and "to the theory model upon which the classes ... are based"; that the articles submitted by the Examining Attorney refer to applicant and its originators and demonstrate that applicant is the owner of the FOUR STAGES mark; and that the mere discussion of its services in the literature does not render its service mark descriptive.

The test for determining whether a mark is merely descriptive is whether the involved term immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product

or service in connection with which it is used, or intended to be used. *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986). It is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods, only that it describe a single, significant quality, feature, etc. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. *In re Recovery*, 196 USPQ 830 (TTAB 1977).

It is clear from the evidence that applicant and its co-founders have developed a theory of career development based on a four-stage model; that other researchers in the career development field have recognized and attributed to applicant and its co-founders the development of this four-stage model; and that other researchers have also developed models for career development based on stages. Applicant, in arguing that FOUR STAGES is not merely descriptive, concedes that FOUR STAGES relates "to the four possible levels of individual competencies assessed by [its]

program" and that FOUR STAGES relates "to the theory model upon which the classes ... are based."

Clearly, the phrase FOUR STAGES is merely descriptive in connection with the identified services because it immediately describes, without conjecture or speculation, a significant feature or function of applicant's services, namely, that applicant's educational services in the area of business management and career development involve teaching about and/or applying the above-described four-stage model. Nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for prospective purchasers of applicant's services to readily perceive the merely descriptive significance of the term FOUR STAGES as it pertains to applicant's services.

Conformance of Drawing to Mark on Specimens

The Examining Attorney contends that the applied-for mark is merely part of the phrase "NOVATIONS FOUR STAGES COMPETENCY ASSESSMENT TOOL," which is "a nondescriptive and distinctive" phrase appearing on the cover of the specimens; that "the words in the phrase all appear in the same color, the same style and the same size font and are spaced equidistant from each other, flowing together to create a continuous circular design"; and that the applied-

for mark is "an inseparable portion of a unitary mark" and "cannot be extracted or viewed apart from the word 'Novations' without altering the visual and aural commercial impression."

Applicant contends, essentially, that the mark FOUR STAGES is shown on the specimens preceded by the company name and followed by descriptive matter, "Competency Assessment Tool" and, therefore, FOUR STAGES is distinguishable as a separate trademark.

Trademark Rule 2.51(a)(1) provides, in part, that "the drawing of the trademark shall be a substantially exact representation of the mark as used on or in connection with the goods[.]" It is well settled that an applicant may apply to register any element of a composite mark if that element, as shown in the record, presents a separate and distinct commercial impression which indicates the source of applicant's goods or services and distinguishes applicant's goods or services from those of others. See, e.g., *In re Chemical Dynamics Inc.*, 839 F.2d 1569, 5 USPQ2d 1828 (Fed. Cir. 1988); and *Institut National des Appellations D'Origine v. Vintners Int'l Co., Inc.*, supra at 1197 (Fed. Cir. 1992), citing *In re Servel, Inc.*, 181 F.2d 192, 85 USPQ 257 (CCPA 1950); *In re Berg Electronics, Inc.*, 163 USPQ 487 (TTAB 1969); *In re Tekelec-Airtronic*,

188 USPQ 694 (TTAB 1975); *In re Lear Siegler, Inc.*, 190 USPQ 317 (TTAB 1976); and *In re San Diego National League Baseball Club, Inc.*, 224 USPQ 1067 (TTAB 1983). See also, *Trademark Manual of Examining Procedure*, sections 807.14(a) and 807.14(b) and cases cited therein.

We find that the applied-for mark, FOUR STAGES, does not present a separate and distinct commercial impression apart from the composite mark shown on the specimens of record. The composite mark consists of wording, forming a circle around the letter "N," that includes, as the upper half of the circle, the phrase "NOVATIONS FOUR STAGES" and, as the lower half of the circle, the phrase "COMPETENCY ASSESSMENT TOOL." This wording appears all in the same size and color print. The wording FOUR STAGES does not stand out as a separable element but, at the very least, would be viewed as part of the phrase "NOVATIONS FOUR STAGES." The fact that NOVATIONS forms part of applicant's name does not result in FOUR STAGES creating a separate commercial impression because of the way the phrase is presented.

*Specimens as Evidence of Service Mark Usage*²

The Examining Attorney contends that "the specimens are surveys used to assess an employee's performance, and not advertisements for seminars relating to business management and career development"; that the specimens do not "in any way refer to the educational seminars and workshops of applicant"; and that "at most, [the specimens] suggest that applicant provides services in the nature of administering services used to evaluate employment skills and competencies [which] clearly falls outside the scope of applicant's [identified] services." The Examining Attorney argues that, unlike menus which are acceptable specimens showing use of a mark in connection with restaurant services, the surveys submitted as specimens in this case "do not suggest that they are part of and/or related to educational seminars and workshops in the area of business management and career development."

Applicant contends that the specimens are used in conjunction with applicant's services in much the same way as a menu is used in conjunction with restaurant services;

² Since we have found the applied-for mark to be a mutilation of the mark appearing on the specimens, we consider this refusal in the alternative, *i.e.*, assuming, *arguendo*, that the applied-for mark appears on the specimens as a separately registrable mark, the question is whether the specimens are acceptable evidence of the use of the mark in connection with the identified services.

and that FOUR STAGES is clearly used on the specimens in an advertising context.

The term "service mark" is defined, in pertinent part, in Section 45 of the Trademark Act, 15 U.S.C. 1127, as "any word, name, symbol, or device, or any combination thereof (1) used by a person . . . to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown." As the Board stated in *In re Moody's Investor's Services, Inc.*, 13 USPQ2d 2043, 2047 (TTAB 1989),

Implicit in this statutory definition is a requirement that there be a direct association between the mark sought to be registered and the services specified in the application, i.e., that it be used in such a manner that it would be readily perceived as identifying such services. (*citations omitted.*)

The question before us is whether the specimens of record are acceptable as evidence of service mark use in connection with the identified services. There is no requirement that the specimens must, in all cases, contain a statement as to the nature of the services. See, *In re Metriplex, Inc.*, 23 USPQ2d 1315 (TTAB 1992); *In re Eagle Fence Rentals, Inc.*, 231 USPQ 228 (TTAB 1986). However, while the nature of the services does not need to be specified in the specimens, there must be something that

creates in the mind of the purchaser an association between the mark and the services provided. *In re Johnson Controls Inc.*, 33 USPQ2d 1318, 1320 (TTAB 1994).

In this case, assuming, *arguendo*, that the applied-for mark is not a mutilation of the composite mark shown on the specimens, we agree with applicant that the brochure submitted as a specimen calls for the recipient to assess either his or her own career "competencies" or those of a colleague. Certainly, such an exercise could reasonably be used by applicant as part of its rendering of its identified educational services. While the mark on this brochure may not be advertising, as noted above, there is no requirement that a service mark must be used in the advertising of the identified services. We find that the mark on this brochure is acceptable evidence of use of the mark in the rendering of applicant's services, and that it is sufficient to create in the minds of purchasers an association between the mark and the services provided.

Decision: The refusal to register is affirmed on the grounds that the applied-for mark is merely descriptive, under Section 2(e)(1) of the Act, and that the applied-for mark is an incomplete representation, *i.e.*, a mutilation, of the mark as used on the specimens of record. However, the refusal to register on the ground that the specimens are unacceptable because they do not show service mark use is reversed.

E. J. Seeherman

C. E. Walters

H. R. Wendel
Administrative Trademark Judges,
Trademark Trial and Appeal Board